

(i.e., why there is no general inventive concept) specifically describing the unique special technical feature in each group.

The December 31 Office Action does not explain why each designated inventive group lacks unity with each other group, specifically describing the unique special feature in each group.

MPEP §1893.03(d) points out that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical feature" is defined as "those technical features that define the contribution which each claimed invention, considered as a whole makes over the prior art." See page 1800-19 of the MPEP. Thus, an Office Action must explain why whatever is identified as a common or corresponding special technical feature is explained in terms of how that feature defines over the prior art.

Additionally, Annex B of the PCT Administrative Instructions, found in the manual of Patent examining Procedure, sets forth the instructions to be followed in determining unity of invention. As pointed out in paragraph (c) on page AI-36, "[U]nity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." Paragraph (c)(i) of Annex B states that if the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises with respect to the dependent claims. Paragraph ©(ii) of Annex B goes on to state that if, however, an independent claim does not avoid the prior art, the question of whether there is still an independent link between all the claims dependent on that independent claim needs to be carefully considered.

These requirements, which are a prerequisite to making a Restriction Requirement complying with the unity of invention requirements, were not met in the December 31, 2002 Restriction Requirement.

The outstanding Restriction Requirement merely states that the invention listed as Groups I - IV lack the same or corresponding special technical features for the following reasons: Group II does not require the structure, or means of groups I and V, group IV has separate image reproduction means from Group I, and Group III defines different information from that of Group II."

This explanation fails to comply with the explicit requirements of 37 C.F.R. §1.499 and MPEP §1893.03(d) and Annex B of the PCT Administrative Instructions, found in the MPEP, because it (1) does not list the common or corresponding technical features of the four identified groups of claims; (2) does not identify the prior art; (4) and does not demonstrate whether any such common or corresponding technical feature is "special", i.e., defines over the prior art.

Moreover, because the Office Action did not follow its own Rules of Practice and Manual of Patent Examining Procedure (MPEP), Applicants have been denied both procedural and substantive due process as required in general under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Thus, the Restriction Requirement is fundamentally improper and must be withdrawn because it fails to comply with the explicit requirements of the aforementioned Rules of Practice and failed to make out a prima facie case of lack of unity of invention, which is a prerequisite to a proper Restriction Requirement in a PCT National Stage application.

Additionally, all claims should be examined on their merits because they all evidence unity of invention, including "commonly recited special technical features" for reasons stated below.

Independent claims 1, 16, 19, 22 and 25 contain several commonly recited special technical features. Claim 1, for example, recites "an optical disk in which is included synchronization data for synchronizing with at least one of sound data and image data, within

at least one of the sound data and image data." Claim 16 commonly recites "an optical disk in which is included synchronization data for synchronizing with at least one of sound data and image data, within at least one of the sound data and image data . . ." Claim 19 recites "an optical disk in which is included synchronization data for synchronizing with sound data, within the sound data . . ." Claim 22 recites "an optical disk in which is comprised synchronization data for synchronizing with sound data, within the sound data . . ." Claim 25 recites a method for reading data from "an optical disk in which is included synchronization data for synchronizing with at least one of sound data and image data, within at least one of the sound data and image data."

Similarly, all five independent claims commonly recite technical features concerning (1)"for reproducing at least one of a sound and an image . . . from the optical disk", and (2) "in synchronization with at least one of sounds and images" (or "for synchronizing with a tune") "based on synchronization data accessed from the optical disk."

Thus, all five independent claims recite at least three commonly recited technical features, each of which are presumed to be "special" absent a showing by the Office that each is unpatentable over prior art. As noted above, the Office has not made such a showing. Because the independent claims presumably all contain a number of commonly recited special technical features, all claims, whether they are independent or dependent, have unity of invention, and all claims must be examined on their merits.

Another way of stating this is that, because the Office has the burden of making out a prima facie case of lack of unity of invention, and has not done so, the Restriction Requirement is improper and must be withdrawn.

Accordingly, Applicants respectfully request that the Office withdraw the Restriction Requirement and examine all claims on their merits.

It is also respectfully submitted that the subject matter of all claims 1-36 is sufficiently related that a thorough search for the subject matter of any one Group of claims

would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement, and examination of claims 1-36 on their merits are respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Robert J. Webster
Registration No. 46,472

JAO:RJW/sxb

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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